REMARKS

This application has been reviewed in light of the Office Action dated April 6, 2004. Claims 15-30 are pending in this application, of which Claims 15, 22, 24, and 29 are in independent form. Claims 15-17, 22-26, 29, and 30 have been amended to define still further what Applicant regards as his invention, and Claim 28 has been amended to ensure consistency of terminology. Favorable reconsideration is requested.

Applicant wishes to thank the Examiner and her supervisor for the courtesy extended his representative in conducting a telephone interview on March 18, 2004. The substance of the interview is presented below for the record.

The outstanding Office Action concludes that the Amendment And Petition For Extension Of Time filed on November 18, 2003, was non-responsive because in the Examiner's view, pending Claims 15-30 are directed to an invention that is "independent or distinct" from the invention originally claimed (paragraph 3 of the Office Action). Because an action on the merits of the original claims had been received, the Examiner deemed that Applicant had constructively elected the originally presented invention for prosecution on the merits, and thus deems non-responsive Amendment And Petition For Extension Of Time filed on November 18, 2003, which canceled all claims drawn to the "elected" invention, and presented only new Claims 15-30.

For the Examiner's view to be correct, it is necessary that the claims presented by amendment be ones which, if they had been presented originally together with the actual original claims, could have been made the subject of a restriction requirement. 37 C.F.R. § 1.142. It is noted that the outstanding Office Action (like that of February 25, 2004) does not explain what the basis for any such restriction requirement would have been. Since Applicant has thus not been provided with sufficient information to enable him to evaluate the Examiner's view and determine what response would be appropriate, it appears to Applicant that both

Actions are incomplete. Nonetheless, after a review of the relevant portions of Chapter 800 of the MPEP, it is found to be impossible to agree with the Examiner. To begin with, there is not seen to be any basis on which the new claims could be deemed to be entirely independent of (that is, unrelated to) the original ones. Rather, both the current claims and the original ones (and, for that matter, Claims 15-30 as first presented in the Amendment dated November 18, 2003) are directed to the same type of apparatus (or method, as the case may be). Nor are the current claims (or Claims 15-30 as first presented) directed to one embodiment and the original claims to another, patentably distinct embodiment, such as would have supported a proper election-of-species requirement. Moreover, it is not seen to be the case that the current claims (or Claims 15-30 as first presented) and the original claims define respectively a combination and a sub-combination usable separately, or separately classified inventions, or inventions for which any other possible basis for restriction could be found. Accordingly, Applicant strongly urges that Claims 15-30 should be examined without requiring Applicant to file a divisional application for that purpose.

If for any reason the Examiner maintains her view, she is respectfully requested in her next paper to set out in full the particular basis for restriction that in her view would have been available had the current claims been presented together with the original ones in the application as filed.

Moreover, it is also respectfully pointed out that the MPEP requires that 37 C.F.R. § 1.142 is properly applied only where the Examiner determines that examining the newly presented claims would impose an unreasonable burden on the Examiner. MPEP § 811. It is noted that neither the outstanding Office Action, nor that of February 25, 2004, makes such an assertion, much less explains which new claim features would require searching that would impose such unfair burden. Should the Examiner maintain her position, therefore, she is also

requested in her next paper to explain in what way examining the new features in the current claims would result in an unfair burden.

Applicant submits that independent Claims 15, 22, 24, and 29, together with the remaining claims dependent thereon, are patentably distinct from the cited prior art for at least the following reasons.

In the Office Action dated July 18, 2003, Claims 1, 2, 8, and 9 were rejected for obviousness-type double patenting over Claims 1 and 8 of U.S. Patent No. 5,777,617 (*Kishimoto*), and under 35 U.S.C. § 102(e) as being anticipated by *Kishimoto*; Claims 6 and 13 were rejected as being anticipated by U.S. Patent No. 6,436,809 (*Hayashi*); Claims 3 and 10 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Kishimoto* in view of purportedly well-known prior-art; Claims 4, 5, 11, and 12 were rejected as being unpatentable over *Kishimoto* in view of Japanese Laid-Open Patent Application JP 409130573 (*Teramoto*); and Claims 7 and 14 were rejected as being unpatentable over *Hayashi* in view of U.S. Patent No. 6,078,399 (*Kadota*). Cancellation of these claims renders their rejections moot; however, Applicant will address the cited references with respect to Claims 15-30 as presented above.

Claims 15 and 24

The aspect of the present invention set forth in Claim 15 is an image processing apparatus having receiving means for receiving image information, wherein the image information includes a code to indicate whether the image information is permitted to be output. A control means is provided for controlling storage and output of the image information. A storage means is provided for storing, according to control by a control means, the image information received by the receiving means. An output means is provided for outputting the image information received by the receiving means in accordance with the code in the image information. A discriminating means is provided for discriminating among modes used in

outputting the image information via the output means. The control means controls the storage means so that the image information output by the output means is not retained in the storage means after the image information is output by the output means.

Kishimoto relates to an output apparatus having a mode in which image data is deleted from a page buffer after being output and another mode in which image data is retained after being output.

Nothing in *Kishimoto* teaches or suggests image information including a code to indicate whether the image information is permitted to be output and a control means that controls a storage means so that the image information output by the output means is not retained in the storage means after the image information is output by the output means. To the contrary, *Kishimoto* states that "if...mode B is selected, after the image data has been developed into the image memory 25, the print data corresponding to the image data in the page buffer 23 is not deleted." *Kishimoto* at col. 4, lines 34-37 (emphasis added). Moreover, *Kishimoto* is utterly silent as to a code included in the image information to indicate whether the image information is permitted to be output.

While anticipation is not an *ipsissimis verbis* test, it is well-established that in order for a reference to anticipate a claim "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." MPEP § 2131 (quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)). The Examiner, citing col. 4, lines 16-20 and 24-27 of *Kishimoto*, states that:

> After, the print mode, test mode A, B or normal is determined (S6), the image information is output (S15), and then deleted from page buffer (23)...

Office Action at 6. However, this description is incorrect, in that, as noted above, if test mode B is selected, the image data is not deleted from the page buffer. Thus, *Kishimoto* discloses an apparatus that deletes the image information after output in certain modes but retains it in other

modes. This points in a direction different from the objectives of the present invention, as discussed beginning at page 4 of the specification, such as preventing image information from being used without authorization. More fundamentally, *Kishimoto's* apparatus clearly does not control output so that the image information is not retained in the storage means after the image information is output by the output means, as recited in Claim 15. Nor, to reiterate, does *Kishimoto* teach or suggest a code included in the image information to indicate whether the image information is permitted to be output. Thus, *Kishimoto* cannot reasonably be said to disclose the "identical invention" as that of Claim 15.

Accordingly, Applicant submits that Claim 15 is patentable over *Kishimoto*.

Independent Claim 24 is a method claim that corresponds to apparatus Claim 15 and is believed to be patentable for at least the same reasons as discussed above in connection with Claim 15.

Claims 22 and 29

The aspect of the present invention set forth in Claim 22 is an image processing apparatus connectable to an image output apparatus including a first determining means for determining whether image data to be transmitted to the image output apparatus is a specific image. A second determining means for determining in accordance with the determination from the first determining means an output mode in which image data is outputted by the image output apparatus. A conversion means is provided for converting a format of the image data in accordance with the output mode determined by the second determining means. A transmitting means is provided for transmitting the image data converted by the conversion means to the image output means.

Hayashi, as understood by Applicant, relates to transmitting image information over a transmission line. In *Hayashi*, input image information undergoes a color conversion

process, then is separated into a first piece of image data and a second piece of image data, selection data in a multilayer data processing is performed, and finally transmission data in the multilayer data format is output. If the image information is determined to be a monochrome image, the selection section selects the transmission data in a 1-layer data format and then the transmission data is output.

Nothing has been found in *Hayashi* that teaches or suggests a conversion means for converting a format of the image data in accordance with the output mode determined by the second determining means, as recited in Claim 22.

Further, the Office Action cites col. 5, lines 7-11, of *Hayashi* as disclosing determining whether image data to be transmitted to the image output apparatus is a specific image. Applicant respectfully disagrees. Col. 5, lines 7-11, merely states that the determination section analyses the first piece of image data IM1, the second piece of image data IM2, and the selection data output by the attribute separation section 11 and determines whether or not each data plane contains significant information. However, nothing has been found, or pointed out, in *Hayashi* that would teach or suggest determining whether or not an image to be transmitted to the image output apparatus is a specific image, as recited in Claim 22. The cited reference of *Hayashi* only discusses pieces of image data and not the complete image.

Accordingly, Applicant submits that Claim 22 is patentable over *Hayashi*.

Independent Claim 29 is a method claim that corresponds to apparatus Claim 22 and is believed to be patentable for at least the same reasons as discussed above in connection with Claim 22.

Conclusion

A review of the other art of record including *Teramoto* and *Kadota* has failed to reveal anything that, in Applicant's opinion, would remedy the deficiencies of the art

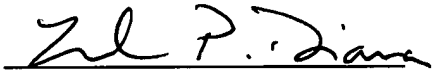
discussed above, as applied against the independent claims herein. Therefore, those claims are respectfully submitted to be patentable over the art of record.

The other rejected claims in this application depend from one or another of the independent claims discussed above, and, therefore, are submitted to be patentable for at least the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, individual consideration of the patentability of each claim on its own merits is respectfully requested.

In view of the foregoing amendments and remarks, Applicant respectfully requests favorable reconsideration and early passage to issue of the present application.

Applicant's undersigned attorney may be reached in our New York Office by telephone at (212) 218-2100. All correspondence should continue to be directed to our address listed below.

Respectfully submitted,



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